

REMARKS

Upon entry of the foregoing amendment, claims 1-10, 18-27, and 35-37 are pending. Claims 2-7 and 19-25 are amended; claims 11-17 and 28-34 are canceled without prejudice or disclaimer; and new claims 36 and 37 are added. In view of the foregoing amendments and following comments, allowance of all the claims pending in the application is respectfully requested.

Examiner Interview

Applicants thank Examiner Hewitt for granting Applicants' representatives the courtesy of an Examiner Interview on October 21, 2003. The substance of the Examiner Interview is set forth below.

Rejections Under 35 U.S.C. §102, 103

Claims 1, 3-11, 13, 15, 17, 18, 20-28, 30, 32, 24 and 35 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,029,141 to Bezos et al. ("Bezos"). Claims 12, 14, 16, 29, 31, and 33 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Bezos. Claims 2 and 19 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Bezos in view of U.S. Patent No. 6,532,492 to Presler-Marshall ("Presler-Marshall"). Applicants traverse these rejections because Bezos alone or in view of Presler-Marshall does not disclose, teach or suggest each and every element of the claimed invention.

With regard to claim 1, the Examiner indicated during the Interview that claim 1 included "conditional limitations and claim language." Specifically, the Examiner indicated that the language "when the combined address does not satisfy the particular condition, performing the steps of..." as recited in claim 1 included a condition which if not met allowed the remaining elements of claim 1 to be ignored. Hence, the Examiner only considered the elements of ***receiving, generating a combined address, and determining*** in claim 1 with regard to forming the prior art rejections and ignored the elements of ***substituting, generating a modified address, and sending***.

Applicants submit that this rejection is improper on its face. It is well settled that the Examiner must consider each and every element in the claims. Applicants are aware of no case law that allows the Examiner to ignore certain elements of the claim. Applicants welcome the Examiner to provide some basis in the law for this position should he elect to maintain this rejection.

With the elements of claim 1 properly considered, Bezos does not disclose at least the features of:

determining whether the combined address satisfies a particular condition;

and

substituting at least a portion of the combined address with one or more address identifiers to create a modified combined address, wherein the modified combined address satisfies the particular condition

as recited therein. For at least this reason, claim 1 is not anticipated by Bezos. Claim 18 includes elements similar to those discussed above with regard to claim 1. For at least this reason, claim 18 is not anticipated by Bezos.

Nonetheless, solely in an effort to expedite prosecution of this matter and without conceding the propriety of the Examiner's rejection, Applicants have added new claims 36 and 37 that include features similar to those recited in claims 1 and 18, respectively, but which do not include the aforementioned "conditional limitations and claim language." Further, Applicants have amended claims 2-7 and 19-25 to depend from newly added claims 36 and 37, respectively, rather than claims 1 and 18, respectively.

With regard to new claims 36 and 37, Bezos does not disclose at least the features of:

determining whether the combined address satisfies a particular condition;

and

substituting at least a portion of the combined address with one or more address identifiers to create a modified combined address, wherein the modified combined address satisfies the particular condition;

as recited therein. For at least this reason, claims 36 and 37 are not anticipated by Bezos.

Presler-Marshall does not cure the deficiencies of Bezos. In particular, Presler-Marshall does not determine whether the combined address satisfies a particular condition. As is best understood, Presler-Marshall determines whether the size of a candidate object (*i.e.*, a file) exceeds a predetermined criterion. Thus, even if Presler-Marshall were properly combinable with Bezos, which Applicants submit it is not, the combination would not teach the claimed invention. Accordingly, Applicants submit that claims 36 and 37 are patentable over Bezos alone or in view of Presler-Marshall.

Claims 2 and 19 depend from claims 36 and 37, respectively and add additional features thereto. For at least this reason, claims 2 and 19 are patentable over the references relied upon by the Examiner. In addition, claims 2 and 19 each recite:

wherein the combined address satisfies the particular condition if a first size of the combined address does not exceed a specified size, wherein the combined address does not satisfy the particular condition if the first size of the combined address does exceed the specified size, and wherein the modified combined address satisfies the particular condition if a second size of the modified combined address does not exceed the specified size.

Applicants submit that neither Bezos nor Presler-Marshall teach or suggest determining whether a first size of the combined address does or does not exceed a specified size. For at least this additional reason, claims 2 and 19 are patentable over the references relied upon by the Examiner.

Claims 3-9 depend from and add additional features to claim 36 and for at least this reason, are patentable over the references relied upon by the Examiner. Claims 20-26 depend from and add additional features to claim 37 and for at least this reason, are patentable over the references relied upon by the Examiner.

Claim 10 recites:

receiving a modified combined address, wherein the modified combined address is based on a combined address that does not satisfy a

particular condition, wherein the modified combined address includes one or more address identifiers such that the modified combined address does satisfy the particular condition, and wherein the one or more address identifiers represents at least a portion of the combined address.

Applicants submit that neither Bezos nor Presler-Marshall, alone or in combination with one another, teach or suggest this feature because neither reference is pertinent to conditions related to either a combined address or a modified combined address.

Accordingly, claim 10 is patentable over the references relied upon by the Examiner.

Claim 27 recites a feature similar to that discussed above with regard to claim 10. For at least this reason claim 27 is also patentable over the references relied upon by the Examiner.

Claim 35 recites:

an intermediary that generates, in response to a request for the object received by the intermediary, a modified request to be sent to the server, wherein the modified request is based on the request and includes a modified combined address, wherein the modified combined address satisfies a particular condition by including one or more address identifiers that are substituted for at least a portion of a combined address, wherein the combined address identifies both an intermediary address associated with the intermediary and an object address that is determined based on the request, and wherein the combined address does not satisfy the particular condition.

Applicants submit that neither Bezos nor Presler-Marshall, alone or in combination with one another, teach or suggest this feature because neither reference is pertinent to conditions related to either a combined address or a modified combined address.

Accordingly, claim 35 is patentable over the references relied upon by the Examiner.

CONCLUSION

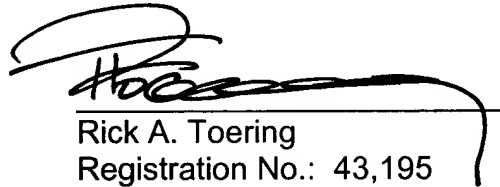
Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

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Respectfully submitted,

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